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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,596	06/29/2001	Matthew Biondi	23952-0151	6504
29052	7590	11/02/2006		
SUTHERLAND ASBILL & BRENNAN LLP 999 PEACHTREE STREET, N.E. ATLANTA, GA 30309			EXAMINER, APPLE, KIRSTEN SACHWITZ	
			ART UNIT	PAPER NUMBER
			3693	

DATE MAILED: 11/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/893,596

Applicant(s)

BIONDI ET AL.

Examiner

Kirsten S. Apple

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 6/30/06.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Claim Rejections - 35 USC § 112***

In view of the applicants amendments the 112 rejections is hereby withdrawn.

***Claim Rejections - 35 USC § 103***

The Examiner has read and reviewed all of the information provided by the Applicant.

The examiner rejects as final claims 1-40 under 35 USC 103.

The Applicant attention is re-drawn to the following:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wallman (U.S. Patent 6,161,098) in view of Frank (U.S. Patent 6,240,399 B1.)

**Re claim 1:** Wallman discloses:

*A method for generating a securities trading proposal, comprising:*

*Generating a trading proposal, (see Wallman, Figure 5)*

*For tax lots of a single security across a plurality of accounts (see Wallman, column 7, line 21-24, "tax consequence from trading multiple assets")*

*Generating a failure report (see Wallman, column 4, line 49-55 "outputting a list of assets/liabilities to sell")*

Although Wallman does not specifically have inputting selection criterion (although Wallman alludes to it in Figure 2), Frank clearly shows "selection criterion" in Figure 1, item 24.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to add selection criteria as taught in Frank to Wallman.

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It is clear that one would be motivated to give control and input to the user.

**Re claim 2:** Wallman discloses:

*Inputted selection criteria include:*

*i) identification of a single security (see Wallman, Fig 2, "security")*

*II) identification of criteria corresponding to the tax lots (see Wallman, column 3, line 18-21, "tax based on ... securities")*

*iii) identification of criteria corresponding to the plurality of accounts (see Wallman, column 7, line 21-24, "tax consequence from trading multiple assets")*

**Re claim 3:** Wallman discloses:

*Include tax filter rules (see Wallman, Figure 5, "capital tax gain")*

*& gain/loss rules (see Wallman, Figure 4, "capital gain")*

**Re claim 4:** Wallman discloses:

*Tax filter rules Include short-term rollover criterion and wash sale criterion (see Wallman, column 14, line 63-69, "takes into account tax rules")*

**Re claim 5:** Wallman discloses:

*Gain/loss rules based on cost, gain, loss and tax liability (see Wallman, column 9, line 8-16 "means for distinguishing... capital gain and loss")*

**Re claim 6:** Wallman discloses:

*Account criteria include one of selecting as the plurality of accounts all accounts for which account profiles are maintained and selecting the plurality of accounts from the accounts for which account profiles are maintained based on selected account profile information. (see Wallman, column 3, line 40-41 "plurality of assets/liabilities")*

**Re claim 7:** Wallman discloses:

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*Receiving:*

*security price information (see Wallman, Figure 2, "current price")*

*tax rate information (see Wallman, column 6, line 46 "tax rate of the user")*

*generating trading proposals including gain/loss, applying selection criteria (see Wallman, Figure 2, "current price")*

**Re claim 8:** Wallman discloses:

*Output trading proposal & failure report (see Wallman, column 4, line 49-55 "outputting a list of assets/liabilities to sell")*

**Re claim 9:** Wallman discloses:

*Generating & transmitting reminders of tax lots & failure reports of losses (see Wallman, column 3, line 46-48 "displaying" the examiner claims Official Notice that one of ordinary skill in art at the time of the invention would be able to turn displaying into a push form of transmitting reminders.)*

**Re claim 10:** Wallman discloses:

*Generating reminders of failed tax lots user selected (see Wallman, column 3, line 46-48 "displaying" the examiner claims Official Notice that one of ordinary skill in art at the time of the invention would be able to turn displaying into a push form of transmitting reminders.)*

**Re claim 11:** Wallman discloses:

*Moving a tax lot identified in a failure report of losses to the trading proposal (see Wallman, Figure 5)*

**Re claim 12:** Wallman discloses:

*Format and content of failure report selectable (see Wallman, Figure 5, the failure report would include everything to the left of the axis)*

**Re claim 13:** Wallman discloses:

*Format and content of trading proposal selectable (see Wallman, Figure 2, by clicking on any part of the graph a trading proposal will appear)*

#### **Re Claims 14-40**

The method claims 1-13 are similar to the article of manufacturing claims 14-26 and system claims 27-39. It would be obvious to one of ordinary skill in the art that these claim have similar limitation. Therefore, claims 14-26 & 27-39 are rejected based on the information provided regarding claims 1-13.

#### ***Response to Arguments***

Applicant's arguments filed 6/30/2006 have been fully considered but they are not persuasive.

In particular, and respect to Claim 1 the Applicant argued 1<sup>st</sup>: "Wallman, Frank, or a combination thereof does not teach or suggest the features of (i) a failure report that includes tax lots that are prevented from being traded and (ii) generating a trading proposal... for tax lots of a single security across multiple investor accounts.

The Examiner refutes the argument made by the Applicant and draws the attention to Schmidt page 3, line 28 – page 4, line 8. In particular the system "will reconcile the demand and supply" this is done by evaluation or *negotiation* of the inputs. In addition, the system will allow "scenarios" and "forecasts" these object will be used by a "decision support system."

Applicants argued 2<sup>nd</sup>, “Wallman does not teach or suggest “generating a trading proposal for tax lots... wherein the tax lots are of a single security across a plurality of investor accounts”

The Examiner refutes the argument made by the Applicant and draws the attention to Wallman, Figure 2, both the Applicants invention and Wallman show one or more securities regardless of the portfolio make-up.

Applicants argued 3<sup>rd</sup>, With respect to Claims 9, 22 & 35 the Office Action provides no evidentiary support for such a transmittal of the “displaying of potential proceeds and the potential tax consequences in a “graphical format” additionally Frank makes not mention of “automatic transmittal”

The Examiner refutes the argument made by the Applicant. As the Applicant admits Wallman has “displayed graphical formats” (Response page 16, line 3) the Applicant argues they are responsive to user inputs and not automatic. While the Examiner believes that Official Notice is more than sufficient for “automating a process” the Examiner has provided an additional reference to make it clear on the record (see Eliason, page 3-5).

Applicants argued 4<sup>th</sup>, new claim 40 is allowable.

The Examiner refutes the argument made by the Applicant and explains that all of the features expressed in claim 40 have already been refuted in claims 1-13.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kirsten S. Apple whose telephone number is 571.272.5588. The examiner can normally be reached on Monday - Friday 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-272-6126.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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